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APR 08 2004

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Applicants Docket Number:
DEAV2001/0073 US NP

Applicants:
WEITHMANN, et al

Serial No.
10/065, 994

Filing Date:
12/09/2002

Title of Invention:
PYRIDINE-2,4-DICARBOXYLIC ACID DIAMIDES AND PYRIMIDINE-4,6-DICARBOXYLIC ACID
DIAMIDES AND THE USE THEREOF FOR SELECTIVELY INHIBITING COLLAGENASES

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Signature

Total Number of Pages Sent: 3

Attorney: George G. Wang

Group Art Unit: 1624

Examiner: Habte, Kahsay

To:
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Aventis Pharmaceuticals Inc. template (March 2001)

IN THE UNITED STATES RECEIVING OFFICE

In re Application of
WEITHMANN, et al.

Examiner: Habte, Kahsay

Art Unit: 1624

Application No.: 10/065,994

Filed: 12/09/2002

TELEFAX CERTIFICATE

Title: **PYRIDINE-2,4-DICARBOXYLIC ACID DIAMIDES
AND PYRIMIDINE-4,6-DICARBOXYLIC ACID
DIAMIDES AND THE USE THEREOF FOR
SELECTIVELY INHIBITING COLLAGENASES**

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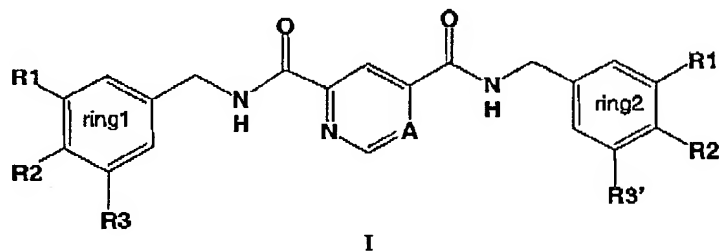
RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

This is in response to the Restriction/Election Requirement imposed by the Examiner in the above-referenced application (Office Communication mailed March 11, 2004). Applicant hereby respectfully traverse said requirement for the reasons detailed below.

The Restriction Requirement

The present invention subjection to the restriction requirement encompasses compounds of formula (I)



The patent claims for those compounds are based on their utility of inhibiting collagen synthesis. Thus, the compounds are unquestionably unified by the common backbone structure (shown in formula I) and the common unity. Yet, the Examiner are trying to divide the invention into arbitrarily two inventions, one directed to compounds of formula (I) wherein A is nitrogen and another directed to compounds of formula (I) wherein A is carbon. The claims subjected to the restriction, which define X1 as C or alternatively N, are of Markush-type. The Examiner's restriction requirement is improper under the PTO own guidelines regarding the Markush-type of claims (MPEP § 803.02). The following paragraphs are excerpts from MPEP § 803.02:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.

.....
Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

It is respectfully submitted that the present invention satisfies the unity requirement stated in the MPEP because the compounds of the invention share a common utility (inhibiting collagen synthesis) and a substantial structural feature being essential to the utility (common structural features of formula (I)). It is further submitted that the Markush group which is currently subject to restriction has only two members (C or N) should be examined without restriction pursuant to the above-cited PTO's own guidelines.

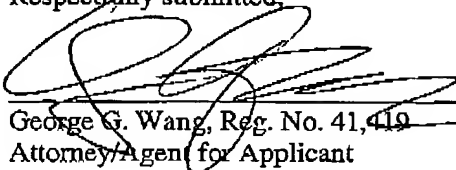
Election of a Single Species

Pursuant to the same section of the MPEP, Applicants hereby elect the compound of example 23 as the initial examining species. It is understood that the claims will be examined fully unless and until any species in the claims are anticipated or rendered obvious by the prior art (MPEP § 803.02).

Provisional Election of an Invention

To fully comply with the Examiner's Restrict Requirement, Applicants hereby provisionally elect group I, which includes claims where A is defined as nitrogen. In the event that the Examiner maintains the restriction requirement, Applicants respectfully request that the Examiner set forth the ground(s) for maintaining the requirement for the record upon which Applicants may further petition.

Respectfully submitted,


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